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OFFICE OF PETITIONS

In re Patent No. 7,456,219	:	DECISION ON REQUEST FOR
Miller et al.	:	RECONSIDERATION OF
Issue Date: November 25, 2008	:	PATENT TERM ADJUSTMENT
Application No. 10/600,132	:	AND NOTICE OF INTENT TO ISSUE
Filed: June 19, 2003	:	CERTIFICATE OF CORRECTION
Attorney Docket No. 24852-501 CIP	:	

This is a decision on the renewed petition filed on August 28, 2009,¹ which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand four hundred sixty-eight (1468) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein**. The term of the above-identified patent is extended or adjusted by **one thousand four hundred forty-seven (1447) days**.

In the present petition, patentee acknowledges that A Delay is 821 days, B Delay is 890 days, and the overlapping period is 169 days. However, patentee asserts that total period of applicant delay is 74 days, not 95 days.

Specifically, patentee disputes the period of reduction of 21 days under 37 CFR 1.704(c)(10) for the filing of the IDS on September 18, 2008. Patentee argues:

¹ This petition was timely filed within two months of the decision on the request for reconsideration of patent term adjustment mailed July 28, 2009.

The Office has maintained the reduction of 21 days of delay allegedly attributed to Applicants under 37 C.F.R. §1.704 for the filing of an Information Disclosure Statement ("IDS") on September 18, 2008. The Decision of July 28, 2009 states that the IDS filed on September 18, 2008 did not include the proper statement under 37 C.F.R. §1.704(d) and upheld the 21 day reduction for this reason. Applicants believe that the 21 day reduction should be withdrawn, because the September 18, 2008 IDS was filed within 30 days of the receipt of the information in the IDS from a foreign patent office. See, e.g., Exhibit A submitted in the Application filed on December 16, 2008. Whether the IDS statement of September 18, 2008 was in proper form is purely a matter of procedure. What is undisputed here is that the IDS was, in fact, filed within 30 days of receipt of the information in the IDS from a foreign patent office and the factual circumstances of the IDS filing within the 30 day time period alone warrants withdrawal of the 21 day reduction, despite the absence of the exact, specific language of 37 C.F.R. 1.704(d) in the IDS statement of September 18, 2008. Applicants respectfully request withdrawal of the 21 day reduction in patent term adjustment erroneously attributed to Applicant delay.

Petition, 08/28/09, p. 3.

It is undisputed that patentee filed the IDS on September 18, 2008, after the mailing of the notice of allowance. A review of the IDS filed September 18, 2008, reveals that it did not include the proper statement under 1.704(d). Specifically, the IDS was accompanied by the following statement:

Applicants hereby certify, as specified in 37 C.F.R. §1.97(e), that **the** item of information contained in this Supplemental Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than thirty (30) days prior to the filing of this Supplemental Statement.

Emphasis added.

The Office reminds patentee that 37 CFR 1.704(d) was revised, effective May 24, 2004.² The required statement states, in pertinent part, that:

[E]ach item of information contained in the information disclosure statement was first cited in **any** communication from a foreign patent office in a counterpart application **and that this communication was not received by any individual designated in § 1.56(c)** more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

(Emphasis added).

Applicants should have mirrored the language as required by 37 CFR 1.704(d). In particular, the Office notes that patentee has still not provided the Office with a statement mirroring the language set forth in § 1.704(d) with the present renewed petition or to date. Thus, the period of reduction of 21 days will remain.

Accordingly, the patent term adjustment is 1447 days (821 days of A delay + 890 days of B delay - 169 days of overlap - 95 days of applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The submission of the \$200.00 fee for the filing of the present renewed petition is unnecessary and will be refunded. No additional fees are required.

² "Section 1.704(d) [was] amended to change 'cited in a communication' to 'first cited in any communication' in order to clarify that the item must have been first cited in **any communication** from a foreign patent office in a counterpart application **instead of merely being cited in such a communication.**" 69 FR 21704 (Apr. 22, 2004) (Emphasis added).

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand four hundred forty-seven (1447) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,456,219 B2

DATED : Nov. 25, 2008

INVENTOR(S) : Miller et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1351 days

Delete the phrase "by 1351 days" and insert – by 1447 days--

PTA Calculations for Application: 10/600132

Application Filing Date:	06/19/2003	PTO Delay (PTO):	890
Issue Date of Patent:	11/25/2008	Three Years:	0
Pre-Issue Petitions:	604	Applicant Delay (APPL):	234
Post-Issue Petitions:	0	Total PTA (days):	1447
PTO Delay Adjustment:	187		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
121	05/04/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	652		
117	07/28/2009	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ISSUE			
116	07/26/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		604	
115	07/26/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	48		
109.5	11/05/2008	PTA 36 MONTHS	69		
109	11/25/2008	PATENT ISSUE DATE USED IN PTA CALCULATION	143		84
108	10/31/2008	EXPORT TO FINAL DATA CAPTURE			
107	10/23/2008	FINISHED INITIAL DATA CAPTURE			
106	10/24/2008	DISPATCH TO FDC			
105	10/08/2008	APPLICATION IS CONSIDERED READY FOR ISSUE			
104	10/08/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
103	01/07/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
102	09/18/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
101	09/18/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		21	104
100	09/18/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
99	09/26/2008	WORKFLOW - QUERY REQUEST - FINISH			
98	09/23/2008	WORKFLOW - QUERY REQUEST - FINISH			
97	09/18/2008	TC RETURN TO PUBS			
96	09/02/2008	MAIL-RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			

95	09/02/2008	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
95	09/02/2008	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE	604		
92	08/01/2008	PETITION ENTERED			
91	08/21/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		3	
91	08/21/2008	ADJUSTMENT OF PTA CALCULATION BY PTO			
90	08/01/2008	MISCELLANEOUS INCOMING LETTER		48	104
89	07/09/2008	MAIL-PETITION DECISION - GRANTED IN PART			
88	07/09/2008	PETITION DECISION - GRANTED IN PART			
87	07/08/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		8	
87	07/08/2008	ADJUSTMENT OF PTA CALCULATION BY PTO			
86	07/08/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	102		
86	07/08/2008	ADJUSTMENT OF PTA CALCULATION BY PTO			
85	04/02/2008	TC RETURN TO PUBS			
84	03/05/2008	ISSUE FEE PAYMENT VERIFIED			
83	03/05/2008	STATEMENT FILED INDICATING A LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS			
82	03/05/2008	ISSUE FEE PAYMENT RECEIVED			
81	02/27/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
77	01/22/2008	PETITION ENTERED			
76	01/16/2008	PUBS CASE REMAND TO TC			
75	01/23/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
74	01/22/2008	WORKFLOW - QUERY REQUEST - BEGIN			
73	01/19/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
72	01/07/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
71	12/17/2007	EXPORT TO INITIAL DATA CAPTURE			
70	12/12/2007	MAIL NOTICE OF ALLOWANCE	26		54
69	12/12/2007	MAIL EXAMINER'S AMENDMENT			
68	12/10/2007	ISSUE REVISION COMPLETED			
67	12/10/2007	DOCUMENT VERIFICATION			
66	12/10/2007	EXAMINER'S AMENDMENT COMMUNICATION			
65	12/10/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			

64	12/10/2007	CASE DOCKETED TO EXAMINER IN GAU			
63	12/10/2007	NOTICE OF ALLOWABILITY			
62	11/01/2007	DATE FORWARDED TO EXAMINER			
61	10/26/2007	SUPPLEMENTAL RESPONSE		102	54
60	04/18/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
59	05/23/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
58	07/19/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
57	07/19/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
56	07/16/2007	RULE 47 / 48 CORRECTION OF INVENTORSHIP PAPERS FILED			
55	07/30/2007	DATE FORWARDED TO EXAMINER			
54	07/16/2007	RESPONSE AFTER NON-FINAL ACTION		32	44
53	07/16/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
52	07/19/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
51	05/23/2007	REFERENCE CAPTURE ON IDS			
50	05/23/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
49	05/23/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
48	07/25/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
47	07/25/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
46	04/18/2007	REFERENCE CAPTURE ON IDS			
45.7	04/18/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
45	04/18/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
44	03/14/2007	MAIL NON-FINAL REJECTION			
43	03/05/2007	NON-FINAL REJECTION			
42	12/19/2006	RULE 47 / 48 CORRECTION OF INVENTORSHIP PAPERS FILED			
41	12/29/2006	DATE FORWARDED TO EXAMINER			
40	12/11/2006	RESPONSE AFTER NON-FINAL ACTION			
39	09/12/2006	MAIL NON-FINAL REJECTION			

38	09/05/2006	NON-FINAL REJECTION			
36	04/06/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
35	03/14/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
34	10/05/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
33	07/25/2006	REFERENCE CAPTURE ON IDS			
31	07/13/2006	DATE FORWARDED TO EXAMINER			
30	06/29/2006	RESPONSE TO ELECTION / RESTRICTION FILED			
29	06/02/2006	MAIL RESTRICTION REQUIREMENT	652		-1
28	05/30/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
27	03/13/2006	CASE DOCKETED TO EXAMINER IN GAU			
26	10/05/2005	REFERENCE CAPTURE ON IDS			
25.7	10/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	10/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	09/02/2005	CASE DOCKETED TO EXAMINER IN GAU			
23	07/13/2005	CASE DOCKETED TO EXAMINER IN GAU			
22	03/14/2005	REFERENCE CAPTURE ON IDS			
21.7	03/14/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	03/14/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
20	12/01/2004	CASE DOCKETED TO EXAMINER IN GAU			
19	07/23/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
18	07/23/2004	CASE DOCKETED TO EXAMINER IN GAU			
17	04/06/2004	REFERENCE CAPTURE ON IDS			
16.7	04/06/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
16	04/06/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	12/22/2003	PRELIMINARY AMENDMENT			
14	03/12/2004	APPLICATION RETURN FROM OIPE			
13	03/12/2004	APPLICATION RETURN TO OIPE			
12	03/12/2004	APPLICATION DISPATCHED FROM OIPE			
11	03/12/2004	APPLICATION IS NOW COMPLETE			
10	02/27/2004	ADDITIONAL APPLICATION FILING FEES		31	7

9	02/27/2004	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
8	02/27/2004	APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS			
7	10/27/2003	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	08/12/2003	CASE CLASSIFIED BY OIPE			
3	08/12/2003	CLEARED BY OIPE CSR			
2	07/15/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	06/19/2003	INITIAL EXAM TEAM NN			

Search Another: Application#

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to [OASIS](#) | [Home page](#)